

### **REMARKS**

Entry of this Amendment is proper under 37 C.F.R. § 1.116, because the Amendment places the application in condition for allowance for the reasons discussed herein; does not raise any new issue requiring further search and/or consideration, because the amendments amplify issues previously discussed throughout prosecution; does not present any additional claims; and places the application in better form for an appeal should an appeal be necessary. The Amendment is necessary and was not earlier presented, because it is made in response to arguments raised in the final rejection. Entry of the Amendment, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are thus respectfully requested.

#### **1. Status of the Claims**

Claims 1-12 stand canceled. Claims 13-35 stand rejected. After entry of the above amendments, claims 13, 15, 16, 23, 27, and 30 are amended; claim 14 is canceled. Thus, claims 13 and 15-35 remain pending.

The claim amendments are supported, for example, in at least the original claims. Thus, no prohibited new matter is believed to have been introduced. Applicants reserve the right to file a divisional or continuation on any subject matter cancelled by way of amendment.

The Office should enter the amendments, because the amendments are made to comply with requirements of form expressly set forth in a previous Office Action and to present rejected claims in better form for consideration on appeal. Specifically, the claims are amended to comply with the 35 U.S.C. § 112 rejections, and to present rejected claims in better form for consideration on appeal.

#### **2. Foreign Priority Documents**

Applicants respectfully request acknowledgement of the claim for foreign priority under 35 U.S.C. § 119 (a)-(d) and receipt of the priority document from the International Bureau.

**3. Information Disclosure Statements**

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements filed March 25, 2008 and April 29, 2008.

**4. Rejection Under 35 U.S.C. & 112, Second Paragraph**

Claims 13-35 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are amended to delete the relative terms and clarify that the weight percent of tea leaf extract is relative to the total volume of the drink. The rejection is mooted by the amendments.

**5. Rejections of the Claims Under 35 U.S.C. § 103(a)**

**5.1 Alleged obviousness over Liu**

Claims 13-16, 18-30, and 32-35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over CN 1237624 to Liu (hereafter "*Liu*"). The Office alleges that *Liu* teaches a drink comprising carbon dioxide, foaming agent and tea leaf extract. The Office acknowledges that *Liu* does not disclose the tea leaf extract in an amount of 0.01% to 3% by weight, but states it would be obvious to vary the amount of tea leaf extract depending on the desired color, taste, and aroma.

Applicants traverse. The Office bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* MPEP § 2142. The Office has established exemplary rationales that may support a conclusion of obviousness. *See* MPEP § 2143. It appears the Office has used either the "obvious to try" rationale or the "teaching, suggestion, or motivation" rationale. In either rationale, there must be a reasonable expectation of success of the modification. Yet, the Office fails to clearly articulate why it would be obvious to modify *Liu* to have between 0.01% and 3% by weight of tea leaf extract in the drink, let alone how this modification would have been reasonably expected to produce the claimed result. The Office must articulate reasons with rational underpinnings to support legal conclusions of obviousness,

not mere conclusory statements. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006).

Additionally, the Office has not established a *prima facie* case of obviousness based on the “obvious to try” rationale. Under the “obvious to try” rationale, the Office must articulate that at the time of the invention there was a recognized problem in the art, a finite number of identified and predictable potential solutions, and a reasonable expectation of success in pursuing the known potential solutions. *See* MPEP § 2143 E. *Liu* suggests to one of ordinary skill in the art the recognized problem of formulating a drink that refreshes, removes fatigue, and whets the appetite. Starting with the problem established by *Liu*, it might be obvious to try different amounts and types of ingredients to produce a drink that refreshes, removes fatigue, and whets the appetite. However, the Office provides no evidence that the optimal amount of tea extract for refreshing, removing fatigue, and whetting the appetite is an amount between 0.01% and 3%. The Office fails to establish the crucial link of optimization to the particularly claimed amount and a reasonable expectation of success of said claimed result. Therefore, the Office provides insufficient factual evidence to support the conclusion that a foam-producing drink containing 0.01% to 3% tea leaf extract is obvious.

The Office also fails to establish a *prima facie* case of obviousness based on the teaching, suggestion or motivation rationale. The Office alleges that one of ordinary skill in the art would have been motivated to vary the amount of tea extract depending on a desired color, taste or aroma, because varying tea leaf extract concentration for those purposes is a common practice in the art. Deficiencies of the cited references cannot be remedied by the general conclusions about what is “common practice.” *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697. Basic knowledge and common sense must be based on evidence in the record. *See* MPEP § 2144.03. Therefore, the Office must provide evidence to support this general conclusion.

Even if the proffered motivation is supported by evidence, a *prima facie* conclusion of obviousness would still not be established. As explained above, the Office fails to establish the crucial link of whether the drink having the desired color, taste, or aroma contains tea leaf extract in an amount between 0.01% and 3%. Following the motivation alleged by the Office, one of ordinary skill in the art might accidentally produce the same drink as claimed, but that is not

sufficient factual support for a *prima facie* case of obviousness. The factual evidence provided by the Office is insufficient to support the conclusion that a foam-producing drink containing 0.01% to 3% tea leaf extract is obvious.

It appears the Office might be concluding the invention is obvious based on foam-holding properties being an inherent aspect of color, taste, and aroma. However, a retrospective view of inherency is no substitute for some teaching or suggestion in the art supporting an obviousness rejection. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); *In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) (“That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.”); *In re Antonie*, 559 F.2d 618, 620, 195 U.S.P.Q. 6, 8 (C.C.P.A. 1977) (holding an obviousness rejection improper, where the prior art did not reveal the property that applicants had discovered); *see also In re Newell*, 891 F.2d 899, 901 (Fed. Cir. 1989); *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983). Applicants discovered the affect of tea leaf extract concentration on foam-holding properties in a drink. *Liu* fails to reveal that relationship or any criticality of adjusting the tea leaf extract concentration. The Office provides no evidence of a relationship either between tea leaf extract concentration and foam-holding properties, or between foam-holding properties and color, taste, and aroma. Without the crucial factual link between the proffered motivation and foam-holding properties, the Office relies improperly on a retrospective view of inherency as a substitute for a suggestion in the art to support the obviousness rejection. Inherency cannot be asserted under 35 U.S.C. § 103. Applicants discovered the optimal concentration of tea leaf extract for foam-holding properties. The Office is using that discovery to conclude that one of ordinary skill in the art would modify *Liu* to produce a drink having between 0.01% and 3% by weight tea leaf extract when optimizing for color, taste, and aroma. Therefore, the Office fails to establish a *prima facie* case of obviousness for claims 13 and 23.

Claim 26 recites “and increasing the foam-holding property of the foam-producing drink.” *Liu* fails to disclose at least that limitation. *Liu* is silent to any foam-holding property, and fails to recognize that tea extract can provide increased foam-holding. The limitation is already recited in claim 26 in the preamble. It appears the Office has ignored the preamble for patentability purposes. Therefore, the limitation has been added to the body of the claim. The

Office fails to address the limitation, much less explain how *Liu* renders this particular limitation obvious.

Dependent claims 14-16, 18-22, 24-25, 27-30, and 32-35, which depend from claims 13, 23, and 26 respectively, are also not obvious for at least the same reasons as for claims 13, 23 and 26. For at least these reasons, no *prima facie* case of obviousness has been adduced, and the rejection should be withdrawn.

### 5.2 Alleged obviousness over Liu in view of Gong Yungao

Claims 17 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Liu* in view of CN 1237624 to Gong Yungao (hereafter “*Gong Yungao*”). The Office appears to rely on *Gong Yungao* solely for modifying *Liu* to include a hop extract. *Gong Yungao* fails to cure the deficiencies of *Liu* with regard to independent claims 13, 23, and 26. Therefore, for at least the reasons provided above, no *prima facie* case of obviousness has been adduced, and the rejection should be withdrawn.

### 5.3 Alleged obviousness over Suzuki

Claims 13-16, 18-30, and 32-35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 04-356,160 to Suzuki et al (hereafter “*Suzuki*”). The Office alleges that *Suzuki* discloses a composition comprising a foaming agent, a tea leaf extract, and air that inherently includes carbon dioxide. The Office acknowledges that *Suzuki* does not disclose the tea leaf extract in an amount of 0.01% to 3% by weight, yet the Office applies the same rationale to find the limitation obvious over *Suzuki* as the Office used for *Liu*. Allegedly, it would be obvious to vary the amount of tea leaf extract depending on the desired color, taste, and aroma. This rationale fails to support the conclusion of obviousness over *Suzuki* for at least the same reasons presented above for *Liu*.

*Suzuki* at least additionally fails to teach the limitation “a foam-producing drink comprising carbon dioxide.” The Office improperly ascertained the differences between the claimed invention and *Suzuki*, because it does not view *Suzuki* for what it teaches as a whole. When ascertaining the differences between the prior art and the claims, the claimed invention as

a whole must be considered. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); MPEP § 2141.02 I. The claimed invention as a whole includes not only what is literally recited, but also inherent properties of the subject matter disclosed in the specification. *In re Antonie*, 559 F.2d 618, 620, 195 U.S.P.Q. 6, 8 (C.C.P.A. 1977). The carbon dioxide of the present invention has the inherent property of making the foam-producing drink carbonated or effervescent. *See, e.g.*, p. 1, ll. 9-12 of the Specification. In contrast, *Suzuki* teaches the addition of air to a composition to form a foamed cream. Foamed creams are neither carbonated nor effervescent. Although air added to the composition of *Suzuki* may include carbon dioxide, *Suzuki* does not teach “a foam-producing drink comprising carbon dioxide.” Unlike *Suzuki*, the claimed invention as a whole includes the inherent and disclosed property of carbonation or effervescence. The Office fails to provide any rationale for why the addition of air in *Suzuki* renders the claimed invention as a whole obvious. Thus, a *prima facie* case of obviousness is also not established for at least this additional reason.

Dependent claims 14-16, 18-22, 24-25, 27-30, and 32-35, which depend from claims 13, 23, and 26 respectively, are also not obvious for at least the same reasons as for claims 13, 23 and 26. For at least these reasons, no *prima facie* case of obviousness has been adduced, and the rejection should be withdrawn.

**D. Alleged obviousness over Suzuki in view of Gong Yungao**

Claims 17 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Suzuki* in view of *Gong Yungao*. The Office appears to rely on *Gong Yungao* solely for modifying *Suzuki* to include a hop extract. *Gong Yungao* fails to cure the deficiencies of *Suzuki* with regard to independent claims 13, 23, and 26 as discussed supra. Therefore, for at least the reasons provided above, no *prima facie* case of obviousness has been adduced. Accordingly, the rejection should be withdrawn.

**6. Response to Arguments**

The Office responded to Applicants argument that the “cited art did not appreciate that tea possessed foam-holding properties” by arguing that foam-holding properties of tea are

inherent. If an explicit suggestion or teaching is missing from a reference, it cannot be supplied by an inherent feature to support an obviousness rejection. *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Inherency is immaterial in an obviousness analysis if the record establishes that one of ordinary skill in the art would not appreciate or recognize the inherent feature. *In re Shetty*, 195 U.S.P.Q. 753 (C.C.P.A. 1977). Therefore, the Office cannot rely on inherency to teach that tea possessed foam-holding properties in the obviousness rejection.

Further, that which may be inherent is not necessarily known, and obviousness cannot be predicated on what is unknown. *In re Spormann*, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966). A retrospective view of inherency is not a substitute for some teaching or suggestion in the prior art supporting an obviousness rejection. *In re Newell*, 13 U.S.P.Q.2d 1248 (Fed. Cir. 1989). Whether tea has foam-holding properties is irrelevant to whether the prior art appreciated that tea possesses foam-holding properties. Because the cited art did not appreciate foam-holding properties of tea, there is no reason to modify *Liu* and *Suzuki* to produce a drink containing 0.01% to 3% tea leaf extract for the reasons presented above.

The Office responded to Applicants argument that the combination of *Gong Yungao* with *Suzuki* or *Liu* fail to teach the foam-holding properties of the tea extract by arguing that *Gong Yungao* is relied upon only as a teaching of a combination of hops and tea leaf extract. We note the Office expressly states that *Gong Yungao* is not used to cure the deficiencies of *Liu* and *Suzuki* with regard to the independent claims.

The Office responded to Applicants argument that the composition of *Suzuki* is not carbonated by arguing that the claims do not require the drink to be carbonated. However, the claimed invention as a whole does require carbonation for the reasons presented above.

### CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited. In the event that there are any questions concerning this amendment or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

If any fees are required, the Office is asked to charge Deposit Account No. 50-0573. The Office can credit any overpayments to the Account.

Respectfully submitted,  
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